

ESTTA Tracking number: **ESTTA578963**

Filing date: **12/26/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	PEI Licensing, Inc.
Granted to Date of previous extension	12/25/2013
Address	3000 NW 107th Ave. Miami, FL 33172 UNITED STATES

Attorney information	Jay M. Burgett Norvell IP LLC 1776 Ash Street Northfield, IL 60093 UNITED STATES officeactions@norvellip.com, jburgett@norvellip.com Phone:773-729-2239
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Applicant Information

Application No	85735078	Publication date	08/27/2013
Opposition Filing Date	12/26/2013	Opposition Period Ends	12/25/2013
Applicant	Pittsburgh Penguins, L.P. 1001 Fifth Avenue Pittsburgh, PA 15219 PANAMA		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: clothing, namely, hockey jerseys, sweatshirts, and jackets

Applicant Information

Application No	85735063	Publication date	08/27/2013
Opposition Filing Date	12/26/2013	Opposition Period Ends	
Applicant	Pittsburgh Penguins, L.P. 1001 Fifth Avenue Pittsburgh, PA 15219 PANAMA		

Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: clothing, namely, hockey jerseys,


sweatshirts, and jackets

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	673912	Application Date	10/28/1957
Registration Date	02/10/1959	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1956/02/21 First Use In Commerce: 1956/02/21 GOLF SHIRTS AND OTHER SPORTSWEAR-NAMELY, SPORT SHIRTS, [BOWLING SHIRTS], SWEATERS [, AND BEACH JACKETS]		


U.S. Registration No.	1116035	Application Date	03/31/1978
Registration Date	04/03/1979	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1977/07/15 First Use In Commerce: 1977/07/15 BARREL BAGS AND GOLF UMBRELLAS		


	Class 025. First use: First Use: 1977/07/13 First Use In Commerce: 1977/11/22 [GOLF CAPS] Class 028. First use: First Use: 1969/00/00 First Use In Commerce: 1969/00/00 GOLF BAG COVERS, GOLF BALLS, GOLF TEES,[RACKET COVERS AND TENNIS BAGS]
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U.S. Registration No.	2075922	Application Date	01/10/1992
Registration Date	07/01/1997	Foreign Priority Date	NONE
Word Mark	PENGUIN SPORT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/01/00 First Use In Commerce: 1992/01/00 clothing; namely, men's, women's and children's tops, shirts, skirts, pullover windshirts, pants, shorts, sweat shirts,jackets, hosiery, hats, scarves, gloves, footwear; activewear; namely, jackets,pullover windshirts, sweaters, shirts, skirts, shorts, pants, swimwear, warm-upsuits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, footwear, hosiery, hats, scarves and gloves; and sportswear; namely, shorts, jackets, pullover windshirts, shirts, skirts,pants, warm-up suits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, hosiery, hats, scarves, gloves and footwear		


U.S. Registration No.	2749389	Application Date	08/17/2001
Registration Date	08/12/2003	Foreign Priority Date	NONE
Word Mark	PENGUIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1967/06/00 First Use In Commerce: 1967/06/00 Slacks, walking shorts, sport shirts, and jackets		


U.S. Registration No.	2870641	Application Date	07/18/2002
Registration Date	08/03/2004	Foreign Priority	NONE

		Date	
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed Penguin with an orange beak and orange feet.		
Goods/Services	Class 025. First use: First Use: 2003/02/00 First Use In Commerce: 2003/02/00 Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks		


U.S. Registration No.	2880454	Application Date	07/18/2002
Registration Date	08/31/2004	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/02/00 First Use In Commerce: 2003/02/00 CLOTHING, NAMELY, KNIT AND WOVEN SHIRTS, T-SHIRTS, SWEATSHIRTS, OUTERWEAR IN THE NATURE OF WIND-RESISTANT JACKETS, JACKETS, COATS, VESTS, PANTS, SHORTS, SWEATERS, HEADWEAR, NAMELY, HATS, CAPS, VISORS AND HEADBANDS, FOOTWEAR, NAMELY SHOES, SNEAKERS AND SANDALS, TIES, WRISTBANDS, BELTS FOR CLOTHING, SWIMSUITS, HOSIERY, UNDERWEAR AND SOCKS		


U.S. Registration No.	3323720	Application Date	03/26/2007
Registration Date	10/30/2007	Foreign Priority Date	NONE

Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR
Design Mark	
Description of Mark	The mark consists of a picture of a penguin and the words An Original Penguin by Munsingwear.
Goods/Services	Class 025. First use: First Use: 2003/02/00 First Use In Commerce: 2003/02/00 Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks

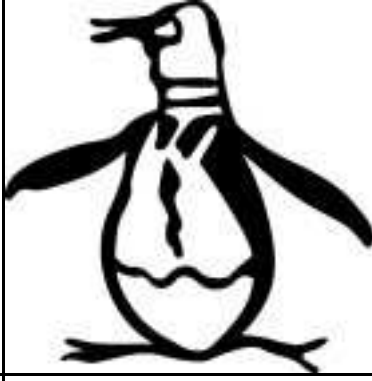
U.S. Registration No.	3681969	Application Date	01/17/2008
Registration Date	09/15/2009	Foreign Priority Date	NONE
Word Mark	ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2007/11/15 First Use In Commerce: 2007/11/15 LUGGAGE, LUGGAGE STRAPS, TRAVEL BAGS, GARMENT BAGS AND SHOE BAGS FOR TRAVEL, BRIEFCASES, BRIEFCASE-TYPE PORTFOLIOS, ATTACHE CASES, MESSENGER BAGS, HANDBAGS, POCKETBOOKS, LEATHER AND FABRIC EVENING BAGS, CLUTCHES, TOTE BAGS, ATHLETIC BAGS, DUFFEL BAGS, BEACH BAGS, DIAPER BAGS, COSMETIC BAGS SOLD EMPTY, TOILETRY CASES SOLD EMPTY, SCHOOL BAGS, KNAPSACKS, WAISTPACKS, UMBRELLAS, WALLETs, BILLFOLDS, BUSINESS CARD CASES, CREDIT CARD CASES, KEY CASES, CHANGE PURSES		

U.S. Registration No.	3717328	Application Date	01/17/2008
Registration Date	12/01/2009	Foreign Priority	NONE

		Date	
Word Mark	AN ORIGINAL PENGUIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 WATCHES, CLOCKS, PARTS OF WATCHES AND CLOCKS, AND THEIR CASES		


U.S. Registration No.	3717329	Application Date	01/17/2008
Registration Date	12/01/2009	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a design of a penguin.		
Goods/Services	Class 014. First use: First Use: 2005/03/00 First Use In Commerce: 2005/03/00 WATCHES, CLOCKS, PARTS OF WATCHES AND CLOCKS, AND THEIR CASES Class 018. First use: First Use: 2007/11/15 First Use In Commerce: 2007/11/15 LUGGAGE, LUGGAGE STRAPS, TRAVEL BAGS, GARMENT BAGS AND SHOE BAGS FOR TRAVEL, BRIEFCASE, BRIEFCASE-TYPE PORTFOLIOS, ATTACHE CASES, MESSENGER BAGS, HANDBAGS, POCKETBOOKS, LEATHER AND FABRIC EVENING BAGS, CLUTCHES, TOTE BAGS, ATHLETIC BAGS, DUFFEL BAGS, BEACH BAGS, DIAPER BAGS, COSMETIC BAGS SOLD EMPTY, TOILETRY CASES SOLD EMPTY, SCHOOL BAGS, KNAPSACKS, WAIST PACKS, UMBRELLAS, WALLET, BILLFOLDS, BUSINESS CARD CASES, CREDIT CARD CASES, KEY CASES, CHANGE PURSES		

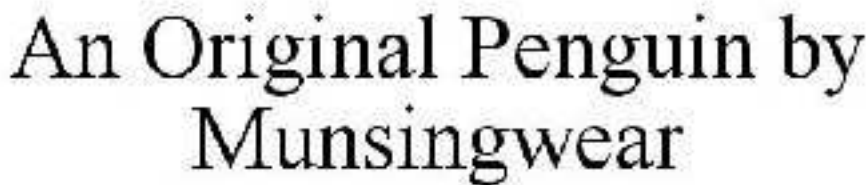
U.S. Registration	3811401	Application Date	03/25/2008
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No.			
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a penguin.		
Goods/Services	Class 025. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 Snowboard boots Class 028. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 Snowboards and snowboard bindings		

U.S. Registration No.	3894274	Application Date	03/25/2008
Registration Date	12/21/2010	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 snowboard boots Class 028. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 snowboards and snowboard bindings		


U.S. Registration No.	3961901	Application Date	10/27/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		

Design Mark	
Description of Mark	The mark consists of the wording "AN ORIGINAL PENGUIN BY MUNSINGWEAR" in stylized form with the letter "M" contained in a square which has four curved sides.
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods

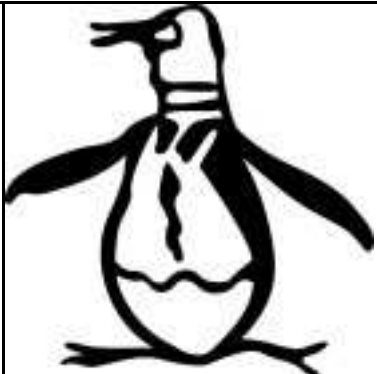
U.S. Registration No.	3961902	Application Date	10/27/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		

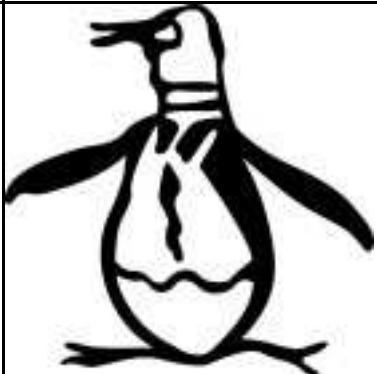
U.S. Registration No.	4032486	Application Date	06/23/2010
Registration Date	09/27/2011	Foreign Priority Date	NONE
Word Mark	ORIGINAL PENGUIN BY MUNSINGWEAR		

Design Mark	Original Penguin by Munsingwear
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2011/04/01 First Use In Commerce: 2011/04/01 fragrances, namely, perfumes, eau de parfum, cologne, eau de toilet, body lotion, bath gel, hand soap, perfumed soap and cosmetics

U.S. Registration No.	4058748	Application Date	11/02/2010
Registration Date	11/22/2011	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed Penguin.		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		


U.S. Registration No.	4058749	Application Date	11/02/2010
Registration Date	11/22/2011	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a dressed Penguin.
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods

U.S. Registration No.	4132700	Application Date	11/11/2010
Registration Date	04/24/2012	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed penguin.		
Goods/Services	Class 003. First use: First Use: 2011/04/01 First Use In Commerce: 2011/04/01 FRAGRANCES, NAMELY, PERFUMES, EAU DE PARFUM, COLOGNE, EAU DE TOILET, BODY LOTION, BATH LOTION, BATH GEL, HAND SOAP, PERFUMED SOAP AND COSMETICS		

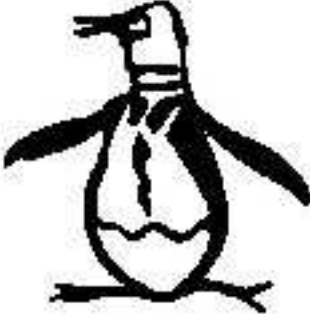
U.S. Registration No.	4263091	Application Date	10/27/2010
Registration Date	12/25/2012	Foreign Priority Date	NONE
Word Mark	PENGUIN		

Design Mark	<h1>Penguin</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods

U.S. Registration No.	4308261	Application Date	07/03/2012
Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	The mark consists of a dressed penguin on the left side with a vertical line separating the design and the words "AN ORIGINAL PENGUIN BY MUNSINGWEAR" in stylized format.		
Goods/Services	Class 035. First use: First Use: 2010/11/11 First Use In Commerce: 2010/11/11 Retail store services featuring apparel, hats, leather goods, fashion accessories, jewelry, footwear, cosmetics, personal care products, eyewear, luggage and sports equipment		

U.S. Application No.	85476255	Application Date	11/18/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		

Design Mark	
Description of Mark	The mark consists of the words "an original Penguin By Munsingwear" in stylized format with the "M" in "Munsingwear" in a dark background.
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 WATCHES, JEWELRY, NAMELY, RINGS, BRACELETS, NECKLACES, CUFFLINKS, AND TIE BARS

U.S. Application No.	85826054	Application Date	01/17/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed penguin.		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes		

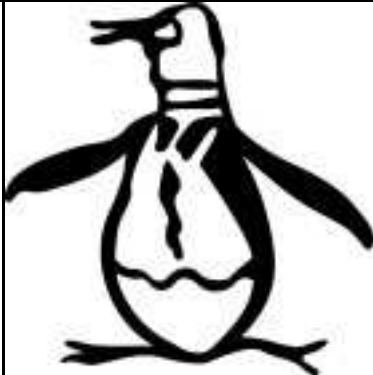
U.S. Application No.	85826140	Application Date	01/17/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ORIGINAL PENGUIN BY MUNSINGWEAR		

Design Mark	ORIGINAL PENGUIN BY MUNSINGWEAR
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes

U.S. Application No.	86104024	Application Date	10/29/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Cases for electronics, namely, iPhones,smart phones, iPads, tablets, headphones, ear buds and stylus		

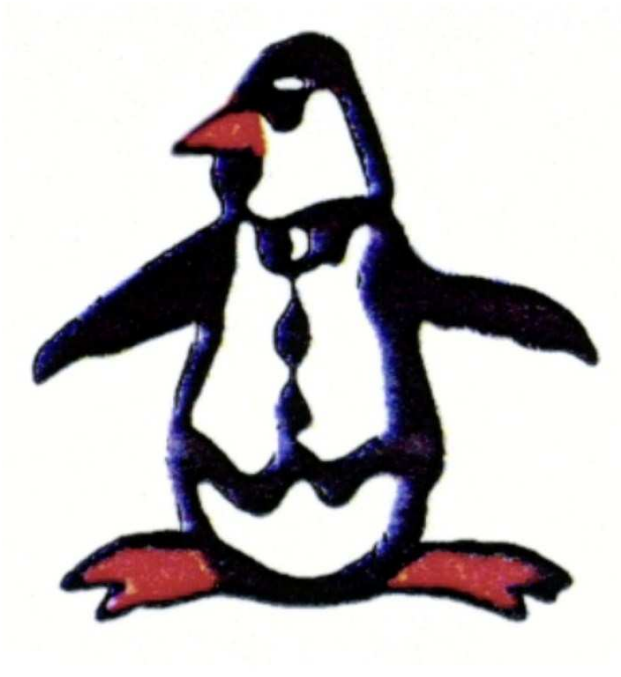
U.S. Application No.	86104025	Application Date	10/29/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		

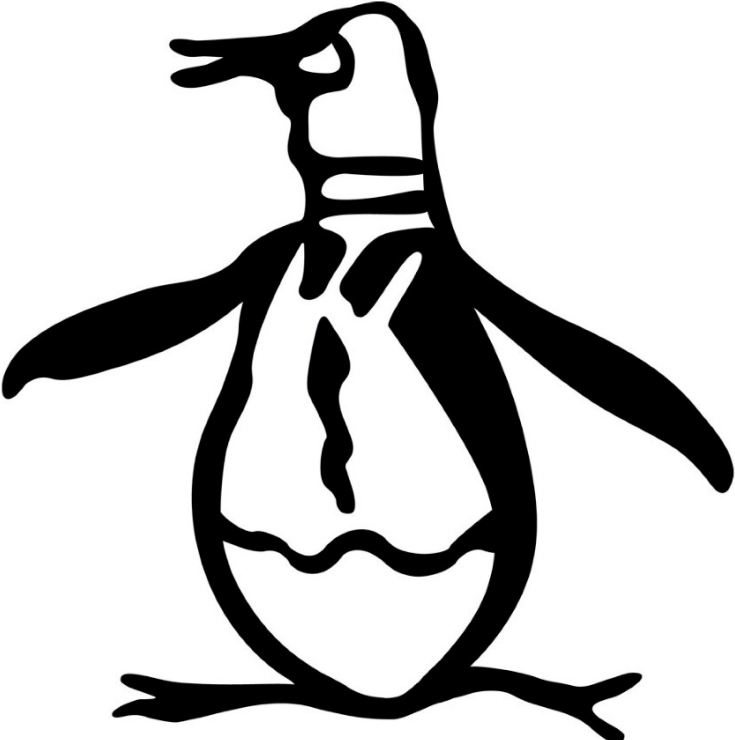
Design Mark	
Description of Mark	The mark consists of the wording "AN ORIGINAL PENGUIN BY MUNSINGWEAR" in stylized form with the letter "M" contained in a square which has four curved sides.
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Cases for electronics, namely, iPhones, smart phones, iPads and tablets, headphones, ear buds and stylus


U.S. Application No.	86104021	Application Date	10/29/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed Penguin.		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Cases for electronics, namely, iPhones, smart phones, iPads and tablets, headphones, ear buds and stylus		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PENGUIN		
Goods/Services	Apparel, accessories, and related goods		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark			
Goods/Services		Apparel, accessories and related goods	
U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark			
Goods/Services		Apparel, accessories, and related goods	
U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	Apparel, accessories, and related goods

Attachments	72039655#TMSN.gif(bytes) 73164596#TMSN.gif(bytes) 74236566#TMSN.jpeg(bytes) 76301300#TMSN.gif(bytes) 78975441#TMSN.gif(bytes) 78975440#TMSN.gif(bytes) 77139980#TMSN.jpeg(bytes) 77373863#TMSN.jpeg(bytes) 77374580#TMSN.jpeg(bytes) 77374640#TMSN.jpeg(bytes) 77430538#TMSN.jpeg(bytes) 77430496#TMSN.jpeg(bytes) 85162396#TMSN.jpeg(bytes) 85162707#TMSN.jpeg(bytes) 85069700#TMSN.jpeg(bytes) 85166869#TMSN.jpeg(bytes) 85166877#TMSN.jpeg(bytes) 85174948#TMSN.jpeg(bytes) 85162406#TMSN.jpeg(bytes) 85668368#TMSN.jpeg(bytes) 85476255#TMSN.jpeg(bytes) 85826054#TMSN.jpeg(bytes) 85826140#TMSN.jpeg(bytes) 86104024#TMSN.jpeg(bytes) 86104025#TMSN.jpeg(bytes) 86104021#TMSN.jpeg(bytes) Penguin design 1 jpg.jpg Penguin design 2 jpg.jpg
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	Penguin design 3 jpg.jpg 131226 Consolidated Notice of Opp - Pittsburgh Penguins (12232-1412).pdf(200961 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.


Signature	/jmb/
Name	Jay M. Burgett
Date	12/26/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No.: 85-735078 & 85-735063

Filed: Sept. 21, 2012




Marks: PITTSBURGH PENGUINS ELITE & 
Published in the *Official Gazette* (Trademarks) on: Aug. 27, 2013

PEI LICENSING, INC.)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
PITTSBURGH PENGUINS, L.P.)	
)	
Applicant.)	

CONSOLIDATED NOTICE OF OPPOSITION

PEI LICENSING, INC., a Delaware corporation with a principal place of business at 3000 NW 107th Avenue, Miami, Florida 33172 ("PEI Licensing") believes that it will be damaged by the registration of the marks: PITTSBURGH PENGUINS ELITE and



 , as shown in Application Serial Nos. 85-735078 and 85-735063, respectively (the "Opposed Mark(s)"), applied for by PITTSBURGH PENGUINS, L.P., a Pennsylvania limited partnership with a principal place of business at 1001 Fifth Avenue, Pittsburgh, Pennsylvania 15219 ("Applicant"), and PEI Licensing opposes registration on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), and dilution under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c). In support of its Opposition, PEI Licensing asserts as follows:

PEI Licensing's PENGUIN Marks

1. PEI Licensing and its related companies are leading marketers of a broad line of apparel, accessories and related goods.





2. PEI Licensing is the owner and licensor of a number of well-known, globally recognized brands, including, for example, PERRY ELLIS[®], JANTZEN[®], LAUNDRY BY SHELLI SEGAL[®], MANHATTAN[®], ORIGINAL PENGUIN[®], and several penguin designs:






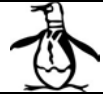

3. PEI Licensing and its related companies' goods are distributed through regional, national and international department stores, national and regional chain stores, mass merchants and green-grass and other specialty stores. PEI Licensing, through its related companies, also engages in direct-to-consumer business through company-owned retail stores and e-commerce websites.




4. PEI Licensing, through its predecessors and/or related companies, adopted and first used a penguin design on or in connection with apparel and related goods since at least as early as 1956 and the PENGUIN word mark since at least as early as 1967. Since that date, PEI Licensing, through its predecessors and/or related companies, has continuously used the penguin design and the PENGUIN word mark, in addition to a number of PENGUIN-formative marks and penguin designs.


5. PEI Licensing owns the following U.S. registrations, all of which are legally and validly registered on the Principal Register of the United States Patent and Trademark Office (“USPTO”) (collectively, the “PEI Registrations”):

Mark	Reg. No.	Goods	Status
	673,912	Golf shirts and other sportswear, namely, sport shirts, sweaters	Incontestable
	1,116,035	Barrel bags and golf umbrellas; golf bag covers, golf balls, golf tees	Incontestable
PENGUIN  SPORT	2,075,922	Clothing; namely, men's, women's and children's tops, shirts, skirts, pullover windshirts, pants, shorts, sweat shirts, jackets, hosiery, hats, scarves, gloves, footwear; activewear; namely, jackets, pullover windshirts, sweaters, shirts, skirts, shorts, pants, swimwear, warm-up suits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, footwear, hosiery, hats, scarves and gloves; and sportswear; namely, shorts, jackets, pullover windshirts, shirts, skirts, pants, warm-up suits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, hosiery, hats, scarves, gloves and footwear	Incontestable
PENGUIN	2,749,389	Slacks, walking shorts, sports shirts, and jackets	Incontestable
	2,870,641	Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands,	Incontestable





Mark	Reg. No.	Goods	Status
		footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks	
	2,880,454	Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind-resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks	Incontestable
	3,323,720	Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks	Incontestable
ORIGINAL PENGUIN BY MUNSINGWEAR	3,681,969	Luggage, luggage straps, travel bags, garment bags and shoe bags for travel, briefcases, briefcase-type portfolios, attache cases, messenger bags, handbags, pocketbooks, leather and fabric evening bags, clutches, tote bags, athletic bags, duffel bags, beach bags, diaper bags, cosmetic bags sold empty, toiletry cases sold empty, school bags, knapsacks, waist	Registered

Mark	Reg. No.	Goods	Status
		packs, umbrellas, wallets, billfolds, business card cases, credit card cases, key cases, change purses	
AN ORIGINAL PENGUIN	3,717,328	Watches, clocks, parts of watches and clocks, and their cases	Registered
	3,717,329	Watches, clocks, parts of watches and clocks, and their cases; Luggage, luggage straps, travel bags, garment bags and shoe bags for travel, briefcase, briefcase-type portfolios, attache cases, messenger bags, handbags, pocketbooks, leather and fabric evening bags, clutches, tote bags, athletic bags, duffel bags, beach bags, diaper bags, cosmetic bags sold empty, toiletry cases sold empty, school bags, knapsacks, waist packs, umbrellas, wallets, billfolds, business card cases, credit card cases, key cases, change purses	Registered
	3,811,401	Snowboard boots; snowboards and snowboard bindings	Registered
AN ORIGINAL PENGUIN BY MUNSINGWEAR	3,894,274	Snowboard boots; Snowboards and snowboard bindings	Registered
	3,961,901	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
AN ORIGINAL PENGUIN BY MUNSINGWEAR	3,961,902	Eyewear and eyewear accessories, namely frames for prescription and non-	Registered

Mark	Reg. No.	Goods	Status
		prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	
ORIGINAL PENGUIN BY MUNSINGWEAR	4,032,486	Fragrances, namely, perfumes, eau de parfum, cologne, eau de toilet, body lotion, bath gel, hand soap, perfumed soap and cosmetics	Registered
	4,058,748	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
	4,058,749	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
	4,132,700	Fragrances, namely, perfumes, eau de parfum, cologne, eau de toilet, body lotion, bath lotion, bath gel, hand soap, perfumed soap and cosmetics	Registered
PENGUIN	4,263,091	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains,	Registered

Mark	Reg. No.	Goods	Status
		eyeglass and sunglass lenses, and cases for all the aforementioned goods	
	4,308,261	Retail store services featuring apparel, hats, leather goods, fashion accessories, jewelry, footwear, cosmetics, personal care products, eyewear, luggage and sports equipment	Registered

6. PEI Licensing also owns the following pending United States trademark applications, which were legally and validly filed with the USPTO (collectively, the “PEI Applications”):

Mark	Ser. No.	Goods	Status
	85-476255	Watches, jewelry, namely, rings, bracelets, necklaces, cufflinks, and tie bars	Allowed
	85-826054	dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes	Allowed
ORIGINAL PENGUIN BY MUNSINGWEAR	85-826140	dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes	Allowed
	86-104021	Cases for electronics, namely, iPhones, smart phones, iPads and tablets, headphones, ear buds and stylus	Pending
AN ORIGINAL PENGUIN BY MUNSINGWEAR	86-104024	Cases for electronics, namely, iPhones, smart phones, iPads, tablets, headphones, ear buds and stylus	Pending
	86-104025	Cases for electronics, namely, iPhones, smart phones, iPads and tablets, headphones, ear buds and stylus	Pending

7. PEI Licensing also owns extensive common law rights in its penguin designs and PENGUIN word marks in connection with a wide variety of apparel, accessories and related goods. PEI Licensing and/or its related companies (hereafter, “PEI”) promotes and sells these goods under its penguin designs and PENGUIN word marks in retail stores and on its website www.originalpenguin.com, where the marks are prominently displayed. The marks reflected in the PEI Registrations and PEI Applications together with the extensive common law rights in the penguin designs and PENGUIN word marks are hereafter referred to as the “PENGUIN Marks.”

8. Long prior to the filing date of the application for the Opposed Marks, PEI extensively advertised, promoted, and sold products bearing the PENGUIN Marks as companion products originating from the same source. The PENGUIN Marks have been so extensively used and advertised together that goods bearing the PENGUIN Marks are recognized by trade and consumers as companions and as originating from a single source. As a result, the PENGUIN Marks constitute a family of PENGUIN Marks that identify PEI Licensing as the source of the goods provided.

9. PEI has expended substantial sums of money in marketing, advertising, and promoting its PENGUIN Marks and, through such sales and advertising, has generated substantial goodwill and customer recognition in its PENGUIN Marks. The public has come to associate the PENGUIN Marks exclusively with PEI Licensing.

10. PEI has derived substantial revenues from the sale of its products under the PENGUIN Marks.

11. PEI’s extensive use and advertising of the PENGUIN Marks have resulted in consumer recognition that the PENGUIN Marks identify PEI Licensing as the source

of fashionable, high-quality products. The PENGUIN Marks are distinctive of PEI's products and are well known and famous, and valuable goodwill has been generated in the PENGUIN Marks. Such goodwill was generated long before the filing date and use of the Opposed Mark.

12. The PENGUIN Marks have become, prior to Applicant's filing and use of the Opposed Mark, distinctive and famous under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

Applicant's Application to Register the Opposed Marks

PITTSBURGH PENGUINS ELITE – Serial No. 85-735078

13. On September 21, 2012, Applicant filed an intent-to-use application to register the Opposed Mark in connection with "Clothing, namely, hockey jerseys, sweatshirts, and jackets" in International Class 25. The application was assigned Serial No. 85-735078.

14. Applicant's filing of the Opposed Mark in connection with apparel is without the consent or permission of PEI Licensing.

15. On July 24, 2013, the USPTO entered an Examiner's Amendment to include a disclaimer of the term "PITTSBURGH."

16. That same day, the USPTO approved the Opposed Mark for publication.

17. On August 7, 2013, the USPTO issued a Notice of Publication and the Opposed Mark was published in the *Official Gazette* of the USPTO on August 27, 2013.



□ - Serial No. 85-735063

18. On September 21, 2012, Applicant filed an intent-to-use application to register the Opposed Mark in connection with "Clothing, namely, hockey jerseys, sweatshirts, and jackets" in International Class 25. The application was assigned Serial No. 85-735063.

19. Applicant's filing of the Opposed Mark in connection with apparel is without the consent or permission of PEI Licensing.

20. On January 20, 2013, the USPTO issued an Office Action requiring, *inter alia*, a new description of the Opposed Mark.

21. On June 7, 2013, Applicant submitted the following description of the Opposed Mark:

The mark consists of a skating penguin with a scarf around its neck and holding a hockey stick in a downward facing triangle and within a circle. A circular border surrounds the inner circle and contains the words "Pittsburgh Elite" and two stars.

22. On July 24, 2013, the USPTO entered an Examiner's Amendment to include a disclaimer of the term "PITTSBURGH."

23. That same day, the USPTO approved the Opposed Mark for publication.

24. On August 7, 2013, the USPTO issued a Notice of Publication and the Opposed Mark was published in the *Official Gazette* of the USPTO on August 27, 2013.

25. Long before Applicant's filing of the Opposed Marks, PEI adopted, first used and registered its PENGUIN Marks on or in connection with apparel. Since then, PEI has continuously used and has not abandoned the PENGUIN Marks.

26. The goods for which Applicant seeks registration of the Opposed Marks are identical or closely related to the goods in which PEI uses its PENGUIN Marks and for which PEI Licensing owns registrations. Applicant seeks to register the Opposed Marks in International Class 25, the identical class in which PEI Licensing owns registrations for its PENGUIN Marks.

OPPOSITION BASED UPON LIKELIHOOD OF CONSUMER CONFUSION

27. PEI Licensing repeats and realleges the allegations of Paragraphs 1 through 26 above, as though fully set forth herein.

28. PEI has used the PENGUIN Marks in United States commerce prior to Applicant's adoption, use, and application to register the Opposed Marks. Moreover, PEI registered its penguin design (Reg. No. 673,912) and PENGUIN word mark (Reg. No. 2,749,389), among other penguin designs and PENGUIN word marks, prior to Applicant's adoption and application to register the Opposed Marks.

29. Applicant's Opposed Marks are confusingly similar to PEI Licensing's family of PENGUIN Marks, and registration and use thereof by Applicant in connection with "Clothing, namely, hockey jerseys, sweatshirts, and jackets" is likely to cause confusion, mistake, or deception that Applicant's goods are those of PEI or are otherwise endorsed, sponsored, or approved by PEI, or cause confusion, mistake, or deception as to the affiliation, connection, or association between Applicant and PEI.

30. If Applicant is permitted to use and register the Opposed Marks in connection with “Clothing, namely, hockey jerseys, sweatshirts, and jackets,” confusion in trade resulting in irreparable damage and injury to PEI Licensing would be caused by reason of the similarity between the Opposed Marks and PEI Licensing’s family of PENGUIN Marks. Consumers are likely to buy Applicant’s products incorrectly believing that such products are provided by, endorsed by, or associated with PEI Licensing.

31. If Applicant is granted registration for the Opposed Marks as shown in Application Serial Nos. 85-735078 and 85-735063, Applicant would thereby obtain a *prima facie* exclusive right to use such marks, and such Registration would be the source of irreparable damage and injury to PEI Licensing.

32. Accordingly, Applicant’s application to register the Opposed Marks must be refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), as amended.

OPPOSITION BASED UPON DILUTION

33. PEI Licensing repeats and realleges the allegations of Paragraphs 1 through 32 above, as though fully set forth herein.

34. Applicant’s commercial use of the Opposed Marks in commerce in connection with “Clothing, namely, hockey jerseys, sweatshirts, and jackets” dilutes, or is likely to dilute, the distinctive quality and reputation of PEI Licensing’s famous PENGUIN Marks under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

35. If Applicant is permitted to use and register the Opposed Marks in connection with “Clothing, namely, hockey jerseys, sweatshirts, and jackets,” dilution of


the distinctive quality and reputation of PEI Licensing's famous PENGUIN Marks would result in irreparable damage and injury to PEI Licensing.

36. Accordingly, Applicant's applications to register the Opposed Marks must be refused registration under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), as amended.

PRAYER FOR RELIEF

WHEREFORE, PEI Licensing prays that the applications to register the marks



PITTSBURGH PENGUINS ELITE and  □, as shown in Application Serial Nos. 85-735078 and 85-73506385-605011, respectfully, be refused.

PEI Licensing submits herewith the requisite filing fee in the amount of \$600. The Board is authorized to charge PTO Deposit Account No. 50-4454 for any additional charges or fees related to this filing.

Respectfully submitted,

PEI LICENSING, INC.

Dated: December 26, 2013

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing CONSOLIDATED NOTICE OF OPPOSITION has been served upon Pittsburgh Penguins, L.P. via United States first class mail, postage prepaid, addressed to:

Clay P. Hughes
Reed Smith LLP
P.O. Box 488
Pittsburgh, Pennsylvania 15230

Conal Berberich
NHL Enterprises, L.P.
1185 Avenue of the Americas
New York, New York 10036

Dated: December 26, 2013

By: /JMB/
Jay M. Burgett